

REMARKS

The Final Office Action mailed November 5, 2007 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Claim Status and Amendment to the Claims

Claims 1-61 are pending.

No Claims stand allowed.

Claims 1, 6, 10, 11, 13, 19, 21, 24-27, 29, 34, 35, 37, 40-44, 48, 49, 53, 54, 56-58 and 61 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. The changes include replacing all occurrences of "said" with "the." Support for these changes may be found in the specification, figures, and claims as originally filed.

The 35 U.S.C. § 102 Rejection

Claims 1-5, 11, 12, 18-20, 26-28, 34-36, 42-46, 49, 50, 52-55, 58, 59, 61 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Veeneman et al.¹, of which Claims 1, 11, 19, 27, 35, 44, 49, 53, and 58 are independent claims.²

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.³

¹ U.S. Patent No. 6,771,650 to Veeneman et al.

² Final Office Action dated November 5, 2007 at ¶ 3.

³ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1

Claim 1 as presently amended recites:

A method for creating a bundle of soft permanent virtual circuits (SPVCs) coupling from a source end to a destination end via a communications network, the method comprising:
creating an SPVC bundle for the source end, the SPVC bundle comprising a plurality of member SPVCs, each member SPVC comprising a permanent virtual circuit (PVC) and a switched virtual circuit (SVC), each of the member SPVCs being associated with a respective connection characteristic and coupling to a same destination; and
transmitting, from the source end to the destination end, an SPVC setup message containing configuration information of the SPVC bundle, the configuration information comprising bumping rules for individual member SPVCs, the bumping rules specifying to which member SPVC traffic should be bumped when a specific member SPVC fails.

With this Amendment, independent claims 1, 11, 19, 27, 35, 44, 49, 53, and 58 have been amended to recite in part that the configuration information comprises bumping rules for individual member SPVCs, where the bumping rules specify to which member SPVC traffic should be bumped when a specific member SPVC fails. Support for this amendment to the claims is found in the application as filed, for example paragraphs 23, 24, 27, and 39. As presently amended independent claims 1, 11, 19, 27, 35, 44, 49, 53, and 58 are not disclosed by the cited art of record, the 35 U.S.C. § 102 rejection of independent claims 1, 11, 19, 27, 35, 44, 49, 53, and 58 as presently amended is unsupported by the cited art of record and the rejection must be withdrawn.

Dependent Claims 2-5, 12, 18, 20, 26, 28, 34, 36, 42-43, 45-46, 50, 52, 54-55, 59, and 61

Claims 2-5 depend from Claim 1. Claims 12 and 18 depend from Claim 11. Claims 20 and 26 depend from Claim 19. Claims 28 and 34 depend from Claim 27. Claims 36 and 42-43 depend from Claim 35. Claims 45-46 depend from Claim 44. Claims 50 and 52 depend from Claim 49. Claims 54-55 depend from Claim 53. Claims 59 and 61 depend from Claim 58.

Claims 1, 11, 19, 27, 35, 44, 49, 53, and 58 being allowable, Claims 2-5, 12, 18, 20, 26, 28, 34, 36, 42-43, 45-46, 50, 52, 54-55, 59, and 61 must also be allowable.

The First 35 U.S.C. § 103 Rejection

Claims 6, 7, 13, 14, 21, 22, 29, 30, 37, 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Veeneman in view of Allan et al.,⁴ among which no claims are independent claims.⁵ This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.⁶

The 35 U.S.C. § 102 rejection of presently amended independent Claims 1, 11, 19, 27, and 35 based on Veeneman et al. is unsupported by the art, as each and every element as set forth in the claims are not found, either expressly or inherently described, in Veeneman et al. Accordingly, the 35 U.S.C. § 103(a) of dependent claims 6, 7, 13, 14, 21, 22, 29, 30, 37, and 38 based on Veeneman et al. and further in view of Allan et al. is unsupported by the art because the combination of Veeneman et al. and Allan et al. does not teach all claim limitations.

⁴ U.S. Patent No. 5,946,313 to Allan et al.

⁵ Office Action at ¶ 5.

⁶ M.P.E.P. § 2143.

The Second 35 U.S.C. § 103 Rejection

Claims 8, 15, 23, 31, 39 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Veeneman in view of Allan et al.,⁷ as applied to claim 7 above, and further in view of Chang et al.,⁸ among which no claims are independent claims.⁹ This rejection is respectfully traversed. The 35 U.S.C. § 102 rejection of independent Claims 1, 11, 19, 27, and 35 based on Veeneman et al. is unsupported by the art, as each and every element as set forth in the claim is not found, either expressly or inherently described, in Veeneman et al. Accordingly, the 35 U.S.C. § 103(a) of dependent claims 8, 15, 23, 31, and 39 based on Veeneman et al. in view of Allan et al. and further in view of Chang et al. is unsupported by the art because the combination of Veeneman et al., Allan et al., and Chang et al. does not teach all claim limitations.

The Third 35 U.S.C. § 103 Rejection

Claims 9, 16, 24, 32, 40, 47, 56 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Veeneman in view of Chang et al.,¹⁰ among which no claims are independent claims.¹¹ This rejection is respectfully traversed. This rejection is respectfully traversed. The 35 U.S.C. § 102 rejection of independent Claims 1, 11, 19, 27, 35, and 53 based on Veeneman et al. is unsupported by the art, as each and every element as set forth in the claims is not found, either expressly or inherently described, in Veeneman et al. Accordingly, the 35 U.S.C. § 103(a) of dependent claims 9, 16, 24, 32, 40, 47, and 56 based on Veeneman et al. and

⁷ U.S. Patent No. 5,946,313 to Allan et al.

⁸ U.S. Patent No. 7,133,420 to Chang et al.

⁹ Office Action at ¶ 6.

¹⁰ U.S. Patent No. 7,133,420 to Chang et al.

¹¹ Office Action at ¶ 7.

further in view of Chang et al. is unsupported by the art because the combination of Veeneman et al. and Chang et al. does not teach all claim limitations.

The Fourth 35 U.S.C. § 103 Rejection

Claims 10, 17, 25, 33, 41, 48, 51, 47, 60 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Veeneman in view of Hamedani et al.¹² ¹³ This rejection is respectfully traversed. The 35 U.S.C. § 102 rejection of independent Claims 1, 11, 19, 27, 35, 53, and 58 based on Veeneman et al. is unsupported by the art, as each and every element as set forth in the claim is not found, either expressly or inherently described, in Veeneman et al. Accordingly, the 35 U.S.C. § 103(a) of dependent claims 10, 17, 25, 33, 41, 48, 51, and 60 based on Veeneman et al. and further in view of Hamedani et al. is unsupported by the art because the combination of Veeneman et al. and Hamedani et al. does not teach all claim limitations.

Claims 44-52

Claims 44-52 are means-plus-function claims. In support of the 35 U.S.C. § 102 rejection of Claims 44-46, 49-50, and 52, and in the support of the 35 U.S.C. § 103 rejections of Claims 47-48 and 51, the Examiner refers to substantially the same portions of the cited references used in the Examiner's rejection of method claims and non-means-plus-function apparatus claims. The Examiner is referred to the U.S. Patent and Trademark Office document entitled "Examination Guidelines For Claims Reciting A "Means or Step Plus Function" Limitation In Accordance With 35 U.S.C § 112, 6th Paragraph" ("Guidelines"), a copy of which is submitted herewith for the Examiner's convenience. The Guidelines state:

... Per our holding, the 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in paragraph six.

¹² U.S. Patent No. 6,560,242 to Hamedani et al.

¹³ Office Action at ¶ 8.

Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a Patentability determination ...

... [The] examiner shall interpret a § 112, 6th paragraph "means or step plus function" limitation in a claim as limited to the corresponding structure, materials or acts described in the specification and equivalents thereof in acts accordance with the following guidelines.¹⁴

The Guidelines state further:

... if a prior art reference teaches identity of function to that specified in a claim, then under Donaldson an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.¹⁵

As Claims 44-52 of the present application are means-plus-function claims they cannot be said to be drawn to identical subject matter as the method claims and the non-means-plus-function apparatus claims. Furthermore, the Examiner has not shown for each means-plus-function claim, that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function. Therefore, the Examiner has not established a *prima facie* case. Accordingly, both the 35 U.S.C. § 102 rejection of Claims 44-46, 49-50, and 52, and the 35 U.S.C. § 103 rejections of Claims 47-48 and 51 must be withdrawn.

In response to the above arguments, the Examiner states:

Regarding claim 44-52, applicant argues that examiner refers to substantially the same portions of the cited references used for other claims. However, the examiner looked into applicant's specification for means plus interpretation at the time of 1st office action. The cited portions teach the limitation described in specification therefore maintains the rejection to claims 44-52.¹⁶

¹⁴ "Examination Guidelines For Claims Reciting A "Means or Step Plus Function" Limitation In Accordance With 35 U.S.C § 112, 6th Paragraph," U.S. Patent and Trademark Office, <http://www.uspto.gov/web/offices/pac/dapp/pdf/exmgu.pdf>, p. 1. (emphasis added)

¹⁵ Guidelines at p. 3. (emphasis in original)

¹⁶ Office Action at p. 4.

The Applicants respectfully submit the M.P.E.P. requires more than a conclusory statement indicating the Examiner “looked into” the specification. Again, under Donaldson, the examiner carries the initial burden of proof for showing that the prior art structure is the same as or equivalent to the structure described in the specification which has been identified as corresponding to the claimed means plus function. As the Examiner has not *showed* that the prior art structure is the same as or equivalent to the structure described in the specification which has been identified as corresponding to the claimed means plus function, the Examiner has not met his initial burden. Accordingly, both the 35 U.S.C. § 102 rejection of Claims 44-46, 49-50, and 52, and the 35 U.S.C. § 103 rejections of Claims 47-48 and 51 must be withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID BROWN
RAYS MAN & STEINER LLP

Dated: March 5, 2008


John P. Schaub
Reg. No. 42,125

THELEN REID BROWN RAYS MAN & STEINER LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040